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Stephan P. Gribok
Duane, Morris & Heckscher LP
One Liberty Place
Philadelphia, PA 19103

In re Application of
Nowak et al. :
US Application No.: 09/936,469 :
PCT Application No.: PCT/DE00/00722 :
International Filing Date: 11 March 2000 :
Priority Date: 12 March 1999 :
Attorney's Docket No.: 3212-24 :
For: FIBER TRANSMISSION ELEMENT :
FOR GENERATING A CHROMATIC :
DISPERSION :
:

DECISION ON PETITION
UNDER 37 CFR 1.181

This decision concerns the "Request for Withdrawal of Notification of Defective Response" filed on 08 August 2003, which is being properly treated as a petition under 37 CFR 1.181 for acceptance into the national stage in the United States.

BACKGROUND

On 11 March 2000, Applicants filed international application PCT/DE00/00722, which claimed priority of an earlier application filed on 12 March 1999. A copy of the international application, in German, was communicated from the International Bureau to the USPTO on 14 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 12 October 2000, the end of the 19-month period from the 12 March 1999 priority date. The period for entering the national stage is thus 30 months and ended at midnight on 12 September 2001.

On 12 September 2001, Applicants filed a transmittal letter for entry into the national stage in the United States (Form PTO-1390), along with, *inter alia*, the \$860 basic national fee required by 35 U.S.C. 371(c)(1) and 37 CFR 1.492(a)(5), an English translation of the international application, and an unexecuted declaration.

On 30 October 2001, a "Notification of Missing Requirements under 37 CFR 371 in the United States Designated/Elected Office (DO/EO/US)" was mailed, requiring submission of an oath or declaration, in compliance with 37 CFR 1497(a) and (b), within the later of 2 months from the mailing date of the notification, or, 32 months from the priority date.

On 04 January 2002, Applicants filed a preliminary amendment, which was mis-construed by the USPTO Office of PCT Operations as a response to the 30 October 2001 notification. Accordingly, on 29 April 2003, a "Notification of Defective Response" (Form PCT/DO/EO/916)

was mailed, setting forth an un-extendable 1-month period for submitting a proper oath or declaration. The instant petition then followed, asserting that a declaration was filed on 13 February 2002, and requesting withdrawal of the 29 April 2003 Form PCT/DO/EO/916.

In addition, the petition contains a request to change the correspondence address for this application. A similar request was filed on 21 July 2003 along with an associate power of attorney. The petition and the requests are separately discussed below.

DISCUSSION

Petition under 37 CFR 1.181

The petition is accompanied by a copy of a postcard receipt date-stamped by the USPTO. The postcard indicates that on 13 February 2002, for this application, the USPTO received, *inter alia*, a signed declaration, a request for a 1-month extension of time, and the \$130 surcharge for not having filed a proper oath or declaration before commencement of the national stage in the United States.

The petition encloses a copy of the declaration purportedly filed on 13 February 2002, containing a "January 29, 2002" Certificate of Mailing date. In addition, the USPTO record indicates that the \$130 surcharge and the \$110 extension-of-time fee were posted to this application on 25 February 2002 with a USPTO "mailroom date" of 13 February 2002. The declaration apparently has not been matched with this file.

Power of attorney and requests to change correspondence address

- (A) On 21 July 2003, an "Associate Power of Attorney (37 CFR 1.34)" was filed, appointing practitioner Richard T. Laughlin as an associate attorney for prosecuting this application before the USPTO, and requesting changing the correspondence address for this application to Richard T. Laughlin's law firm in Morristown, New Jersey, which is not the address indicated in the executed declaration. This communication is signed by a Fritz Tiede, identified as manager of "Thorlabs GmbH."

However, the USPTO record only shows assignment, in November and December of 2001, by the inventors named in this application of their entire interest in the application to Profile Optische Systems GmbH. There is no evidence that Thorlabs GmbH is the current assignee of the entire interest in the application, or that Fritz Tiede is one of the attorneys-of-record. Therefore, Fritz Tiede is not authorized to appoint any associate attorney, or change the correspondence address for this application. MPEP 402.02 (Appointment of Associate Attorney or Agent); 403.01 (Correspondence Held with Associate Attorney); 601.03 (Change of Correspondence Address) (Rev. 1, Feb. 2003).

Consequently, the 21 July 2003 "Associate Power of Attorney (37 CFR 1.34)" is ineffective and has not been entered.

- (B) The instant petition, signed by practitioner Josefino P. De Leon, also requests that future correspondence for this application be mailed to Richard T. Laughlin at the Morristown, New Jersey address.

Josefino P. De Leon is not the practitioner who filed the national stage papers on 12 September 2001; is not named in the 12 September 2001 transmittal letter; and does not appear to have been appointed by Applicants or the assignee to prosecute this application before the USPTO. Moreover, as delineated above, a signed declaration was filed on 13 February 2002, prior to the instant request. Therefore, Josefino P. De Leon, likewise, is not authorized to change the correspondence address for this application. MPEP 601.03; 405 (Attorney Not of Record) (Rev. 1, Feb. 2003).

While a courtesy copy of this decision is being sent to practitioner Josefino P. De Leon, all future correspondence on this application will only be forwarded to the current address-of-record unless the USPTO is properly instructed otherwise.

CONCLUSION

In view of the above, the signed declaration, a copy of which is enclosed with the petition, was timely filed on 13 February 2002. An examination of this declaration reveals that it complies with 37 CFR 1.497(a) and (b). The 29 April 2003 Form PCT/DO/EO/916 was thus mailed in error, and is hereby VACATED. The petition is GRANTED.

Applicants have met the requirements of 37 CFR 1.495 for acceptance into the national stage under 35 U.S.C. 371(c). The application has an international filing date of 11 March 2000 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 13 February 2002.

The application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for further processing



Richard Cole
PCT Legal Examiner
PCT Legal Office



RC Tang
Petitions Attorney
PCT Legal Office
Telephone: 703-308-1315
Facsimile: 703-308-6459

cc: Josefino P. De Leon, Esq. (Docket F-15/03)
Shlesinger, Arkwright & Garvey LLP
3000 South Eads Street
Arlington, VA 22202